

## **II. Objection to Claim 12**

Claim 12 was objected to as allegedly including unclear language. The Office Action states at page 2 that “the phrase ‘two criteria include at least three criteria’ is unclear.” Initially, claim 12 does not include this language. However, claim 13 includes the objected to language. Accordingly, the present objection is addressed as though made to claim 13. While Applicants respectfully disagree with the merits of this objection,, to facilitate matters, claim 13 has been amended herein without prejudice to recite that “the request for taking control is activated in the activating step (b) when at least three criteria including the at least two criteria and one additional criteria are simultaneously satisfied.” It is respectfully submitted that the foregoing amendments obviate this objection, and withdrawal of this objection is therefore respectfully requested.

## **III. Rejection of Claims 9 to 19 Under 35 U.S.C. § 103(a)**

Claims 9 to 19 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,233,514 (“Engelman et al.”). It is respectfully submitted that Engelman et al. do not render claims 9 to 19 obvious for the following reasons.

Claim 9 relates to a method for notifying a driver of a vehicle having an adaptive cruise control and recites that the method includes the steps of signaling that at least one of a maximum braking force and pressure controllable by the adaptive cruise control is being applied and a deceleration therefrom is not sufficient to automatically decelerate the vehicle in time and to a sufficient degree and activating a request for taking control when at least two criteria relating to deceleration values are simultaneously satisfied.

Claim 19 relates to a device for notifying a driver of a vehicle having adaptive cruise control, to inform the driver of an activation of a request for taking control, the request for taking control signaling that one of a maximum braking force and a maximum braking pressure controllable by the adaptive cruise control is being applied and that a deceleration resulting therefrom is not sufficient to automatically decelerate the vehicle in time and to a sufficient degree. Claim 19 recites that the device includes an arrangement configured to activate the request for taking control when at least two criteria relating to deceleration values are simultaneously satisfied.

Engelman et al. purport to relate to an adaptive vehicle cruise control system and methodology. The Office Action states at page 2 that Engelman et al.

"disclose a method for notifying a driver of a vehicle . . . that at least one of a maximum braking force (Fig. 1, #24) and pressure controllable by the adaptive cruise control is being applied." Initially, Engelman et al. merely describe a system that automatically adjusts the speed of the vehicle using a linear equation having variables related to distance and speed. Engelman et al. states that "the control objective for the ACC system is defined to be: maintaining the range R equal to a distance proportional to the times headway plus some minimum distance." Col. 5, lines 7 to 10. Engelman et al. do not disclose, or even suggest, a method for notifying a driver, as recited in claim 9 and 19. Number 24 of Figure 1 merely shows, "a service brake control 24, designated Brake Controller in FIG. 1, that acts to apply braking torque to the wheels via the vehicle's ABS hydraulics." Col. 4, lines 12 to 15. Furthermore, Engelman et al. do not disclose, or even suggest, the step of signaling. Accordingly, Engelman et al. do not disclose, or even suggest, the step of signaling that at least one of a maximum braking force and pressure controllable by the adaptive cruise control is being applied and a deceleration therefrom is not sufficient to automatically decelerate the vehicle in time and to a sufficient degree. The only support that the Office Action provides as to where the features of the rejected claims are purportedly included in Engelman et al. is the reference to "Fig. 1, #24." Number 24 of Figure 1 merely shows, "a service brake control 24, designated Brake Controller," actuated by the vehicle's ABS hydraulics. See Engelman et al., col. 4, lines 12 to 15. Therefore, the Office Action merely recites the features of the claims while relying on a box labeled Brake Controller in Figure 1, but without providing any support from Engelman et al. as to where the features of the rejected claims are purportedly disclosed.

The Office Action admits that Engelman et al. do not disclose activating a request for taking control when at least two criteria relating to deceleration values are simultaneously satisfied. See Office Action at p. 2. Although the Office Action refers to two specific sections of columns 3 and 4, neither col. 3, lines 20 to 55 nor col. 4 lines 20 to 55 of Engelman et al. discloses, or even suggests, the features of claim 9 and 19. Furthermore, there is no suggestion in Engelman et al. to modify the system of Engelman et al., nor any suggestion that it would be successful, or even possible, to modify the system of Engelman et al. to include the features of the rejected claims.

The Office Action alleges on page 3 that “it would have been obvious . . . to modify the system of Engelman et al. by activating a request for taking control when at least two criteria relating to deceleration values are simultaneously satisfied in order to enable system performance to better meet driver expectations under real road conditions.” However, none of these features are disclosed, or even suggested, by Engelman et al., nor does Engelman et al. disclose, or even suggest, the purported motivation to modify the system.

The Office Action alleges on page 3 that “Engelman et al. disclose in Fig. 6 that an incorrect mode of operation of the adaptive cruise control has been detected.” However, Engelman et al. merely state that Figure 6 shows that “the basic control logic,” by which the system may “[default] out to a conventional cruise control function with an automatic resume.” Col. 9, lines 12 to 16. Engelman et al. do not disclose, or even suggest, a signal indicating that an incorrect mode of operation of the adaptive cruise control has been detected, as recited in claim 16.

The Office Action further states that “the further limitations are taught by Engelman et al.” This unsupported assertion is traversed to the extent it is maintained, as no support or clarification for the basis of this assertion is provided.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, Engelman et al. fail to disclose, or even suggest, a method for notifying a driver of a vehicle having an adaptive cruise control, including the steps of signaling that at least one of a maximum braking force and pressure controllable by the adaptive cruise control is being applied and a deceleration therefrom is not sufficient to automatically decelerate the vehicle in time and to a sufficient degree and activating a request for

taking control when at least two criteria relating to deceleration values are simultaneously satisfied, as recited in claim 9. Furthermore, Engelman et al. fail to disclose, or even suggest, a device for notifying a driver of a vehicle having adaptive cruise control, to inform the driver of an activation of a request for taking control, the request for taking control signaling that one of a maximum braking force and a maximum braking pressure controllable by the adaptive cruise control is being applied and that a deceleration resulting therefrom is not sufficient to automatically decelerate the vehicle in time and to a sufficient degree, including an arrangement configured to activate the request for taking control when at least two criteria relating to deceleration values are simultaneously satisfied, as recited in claim 19. It is therefore respectfully submitted that Engelman et al. do not render obvious claims 9 and 19.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the reference do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so,

found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the reference to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the reference relied upon, whether taken alone, combined or modified, would provide the features and benefits of claims 9 and 19. It is therefore respectfully submitted that Engelman et al. do not render obvious claims 9 and 19.

As for claims 10 to 18, which depend from claim 9, and therefore include all of the limitations of claim 9, it is respectfully submitted that Engelman et al. do not render obvious these dependent claims for at least the same reasons given above in support of the patentability of claim 9. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

#### IV. Conclusion

Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached page is captioned "**Version with Markings to Show Changes Made.**"

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

Claim 13 has been amended, without prejudice, as follows:

13. (Amended) The method according to claim 9, wherein the [at least two criteria include at least three criteria, the] request for taking control [being] is activated in the activating step (b) when at least three criteria including the at least two criteria and one additional criteria are simultaneously satisfied.